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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,942	11/13/2003	Thomas J. Kennedy III	P-4628-3-C1-3-D1	9628

24492 7590 03/10/2005

THE TOP-FLITE GOLF COMPANY, A WHOLLY OWNED  
SUBSIDIARY OF CALLAWAY GOLF COMPANY  
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CARLSBAD, CA 92008-7328

EXAMINER

GORDON, RAEANN

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 03/10/2005

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**MAILED**  
**MAR 10 2005**  
**GROUP 3700**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/712,942  
Filing Date: November 13, 2003  
Appellant(s): KENNEDY ET AL.

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Michelle Bugbee  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed December 29, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

4,431,193	NESBITT	2-1984
3,989,568	ISAAC	11-1976
6,359,066	YABUKI	3-2002

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 10-12, 14-18, 21-22, 25, and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nesbitt (4,431,193). Nesbitt discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer. The coefficient of restitution of the core is 0.770 and the coefficient of restitution of the core and inner cover layer is 0.800 or more. Applicant's COR, 0.770 or more, for the ball is an inherent feature of Nesbitt. Nesbitt further disclose the inner cover layer is made from a hard, highly flexural modulus resinous material such as Surlyn 1605 (ionomer), which has a Shore D hardness of 62 (see Yabuki 6,359,066 col 11). The outer cover layer is made from a soft, low flexural modulus resinous material such as Surlyn 1855 (ionomer), which has a Shore D hardness of 55 (see Yabuki 6,359,066 col 11). The spin factor, COR, and PGA compression are considered obvious over Nesbitt since the materials are the same. One of ordinary skill in the art would obviously seek to improve the above mentioned properties for enhanced initial velocity and ball performance.

Claims 13, 19, 20, 23, 24, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt in view of Isaac (3,989,568). Nesbitt discloses the invention as shown above but fails to disclose a polyurethane outer cover. Isaac teaches a polyurethane cover. One skilled in the art would substitute the polyurethane cover of Isaac in the golf ball of Nesbitt to obtain a golf ball with good click and feel (Isaac col. 1, lines 15-30).

Claims 10-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,213,894. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention and the '894 patent claims golf balls comprising a core an inner cover layer made from an ionomer and a cover layer made from an ionomer or polyurethane. The claims differ in that the present invention claims a outer cover hardness up to 55 and the '894 patent claims a hardness up to 53. One of ordinary skill in the art would increase the hardness of outer cover for increased durability.

**(11) *Response to Argument***

The present invention claims a golf ball comprising a core and an inner cover layer with a Shore D hardness of at least 60 formed from a composition which includes at least one material selected from the group consisting of polyphenylene ether/ionomer blends, ionomers, polyamides, polyurethanes, polyester elastomers, polyester amides, metallocene catalyzed polyolefins, and blends thereof. The golf ball also includes an outer cover layer with a Shore D hardness of no more than 55 made from the group consisting of polyphenenylene ether/ionomer blends, ionomers, polyamides, polyurethanes, polyester elastomers, polyester amides, metallocene catalyzed polyolefins, and blends thereof. The properties of the completed golf ball include a spin factor of at least 5-8, a PGA compression of 100 or less, and a coefficient of restitution of at least 0.770. The primary reference, Nesbitt, discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer. The inner cover layer is made from

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Surlyn 1605 (ionomer), which has a Shore D hardness of 62 (see Yabuki 6,359,066, col. 11). The outer cover is made from Surlyn 1855, which has a Shore D hardness of 55 (see Yabuki 6,359,066, col. 11). Appellant disagrees with two aspects of the rejection set forth above (independent claims 10, 15, 22).

First, Appellant argues Nesbitt does not disclose or claim a specific Shore D hardness or limit the cover to materials having a specific Shore D hardness. Appellant's position is completely misunderstood. Nesbitt clearly discloses the inner and outer cover layers may be made from Surlyns 1605 and 1855, respectively (col. 2, lines 35-45). Surlyns 1605 and 1855 are tradenames for specific ionomer resins that are commercially available and have specific properties, such as Shore D hardness. The Yabuki reference is cited to teach the inherent properties of Surlyns 1605 and 1855. Column 11 of Yabuki clearly teaches Surlyns 1605 and 1855 have Shore D hardness values of 62 and 55, respectively. Although Appellant's arguments are silent with respect to the Yabuki reference the Examiner notes, "extra references or evidence can be used to show an inherent characteristic of the thing taught by the primary reference" MPEP 2131.01 III. With respect to the claimed ranges for the materials and Shore D hardness of the inner cover layer and the outer cover layer, specific examples in the prior art which are within a claimed range anticipates the range MPEP 2131.03. In the instant case, Appellant claims an inner cover layer Shore D hardness of at least 60 and an outer cover layer Shore D hardness of no more than 55 (55 or less). Nesbitt discloses an inner cover layer made from Surlyn 1605, which inherently has a Shore D hardness of 62 and an outer cover layer made from Surlyn 1855, which inherently has a

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Shore D hardness of 55. “[W]hen, as by a recitation of ranges or otherwise, a claims covers several compositions, the claim is anticipated if *one* of them is in the prior art.”

*Titanium Metals Corp v. Banner*, 778 F 2d 775, 227 USPQ 773 (Fed Cir. 1985).

Note: the above rejection was affirmed by the BPAI on January 30, 2004 in application 09/873,594.

Second, Appellant further argues the properties of the golf ball. In particular the PGA compression, spin factor, and COR. As support Appellant states the instant specification includes example golf balls made using the materials disclosed in Nesbitt. Appellant states, “Specifically, the COR of finished ball 5 in Table 17 (the ball made with Nesbitt’s materials) is 0.757, which does not meet the limitation of at least 0.770 as claimed by Appellant.”. Appellant is correct, golf ball 5 in Table 17 does not meet the claimed limitation. However, contrary to Appellant’s specification golf ball 5 is not the golf ball disclosed by Nesbitt. Attention is directed to column 3, lines 26-32 of Nesbitt, which gives specific values for the COR of the core and the intermediate ball (core +inner layer):

	<u>Nesbitt</u>	<u>ball 5 (table 17 of instant app)</u>
COR (core)	0.770	0.800 (page 53, lines 8-14)
COR (intermediate ball)	0.800 or more	0.793 (table 16, D)

As shown above, golf ball 5 cannot possibly be the golf ball disclosed by Nesbitt.

Nesbitt clearly discloses a golf ball comprising a core and an inner cover layer with a COR value of 0.800 or more, which is completely different from the example disclosed

by Appellant. Since the COR values for the first two layers are inconsistent with Nesbitt it is not possible for the final golf ball to have a COR of 0.757 as alleged by Appellant. While Nesbitt does not disclose the COR of the final golf ball it is clear the value will definitely fall within the range claimed by Appellant (0.770 or more). The technical reasoning is as follows: Nesbitt discloses the intermediate ball (without outer cover) has a COR of 0.800 or more. The inclusion of an outer cover material that also meets Appellant's limitation (ionomer Shore D of 60 or more) will not lower the COR value below Appellant's claimed range. It is therefore proven the golf ball of Nesbitt is equivalent to the golf ball of the claimed invention and possesses the same properties, (COR, spin factor, and PGA compression) as the ball claimed by Appellant. It should also be noted the PGA compression of less than 100 is the value for nearly all golf ball. Golf balls with a range outside of 80-100 are considered X balls and are not generally used for playing a game of golf.

Appellant does not set forth arguments regarding dependent claims 11, 12, 14, 16-18, 21, 25, and 26. However, as shown throughout the prosecution and as set forth above, Nesbitt clearly discloses the claimed subject matter. Regarding claims 11 and 12, the outer cover of Nesbitt is made from Surlyn 1855 (ionomer). Regarding claims 14 and 26, the spin factor is inherent since the materials are the same as shown above. Regarding claims 16 and 17, the inner cover layer is made from a hard, highly flexural modulus resinous material such as Surlyn 1605 (ionomer), which has a Shore D hardness of 62 (see Yabuki 6,359,066 col. 11). Regarding claims 18, 21, and 25, the



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outer cover of Nesbitt is made from Surlyn 1855 (ionomer), which has a Shore D hardness of 55 (see Yabuki 6,359,066 col. 11).

With respect to claims 13, 19, 20, 23, 24, 27 and 28 in view of Isaac, Appellant argues Isaac discloses a single cover layer and does not disclose a multi-layer cover. The Examiner agrees with appellant on this issue. However, the points argued are not relevant to the motivation or combination of Nesbitt in view of Isaac. Appellant cannot show nonobviousness by attacking references individually where the rejection is based on combinations of reference MPEP 2145 IV. As shown above, the primary reference, Nesbitt, discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer. The inner cover layer is made from a hard, high flexural modulus ionomer such as Surlyn 1605. The outer cover layer is made from a soft, low flexural modulus ionomer, such as Surlyn 1855. Appellant further limits the claims by claiming a polyurethane outer cover. The secondary reference, Isaac, is cited to teach the polyurethane material for the outer cover layer. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is based on the teachings of the references and the knowledge generally available to one skilled in the art. The primary reference, Nesbitt, discloses the outer cover layer should be made from a soft, low flexural

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modulus material (abstract). Since most current day golf balls have covers comprising either ionomers or polyurethane one of ordinary skill in the art would instantly look to polyurethanes because they are known for providing soft cover layers with increased cut resistance. Isaac makes clear, **“One cover material which has been looked at as a substitutes for balata or Surlyn resin is polyurethane** (col. 1, lines 24-25).” Isaac also teaches the use of polyurethane as a cover material for golf ball because, like Surlyn, it has a relatively low price compared to balata and provides superior cut resistance over balata. However, unlike Surlyn cover balls, polyurethane covered golf balls can be made to have the “click” and “feel” of balata (col. 1, lines 26-30). As shown by the teachings of Isaac, the use of polyurethane and ionomer (surlyn) covers is not new in the golf art and the motivation for choosing a polyurethane over an ionomer (surlyn) cover is clearly evident and well established by Isaac.


In conclusion, it is submitted that Nesbitt discloses the claimed invention. Nesbitt, discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer. The inner cover layer is made from Surlyn 1605, which has a Shore D hardness of 62 (see Yabuki 6,359,066, col. 11). The outer cover is made from Surlyn 1855, which has a Shore D hardness of 55 (see Yabuki 6,359,066, col. 11). Although Appellant’s arguments are silent with respect to the Yabuki reference which teaches the inherent properties of the Surlyns the Examiner notes, “extra references or evidence can be used to show an inherent characteristic of the thing taught by the primary reference” MPEP 2131.01 III. Since the material make-up of the golf ball disclosed by Nesbitt encompasses Appellant’s the COR, PGA compression and spin factor limitations are

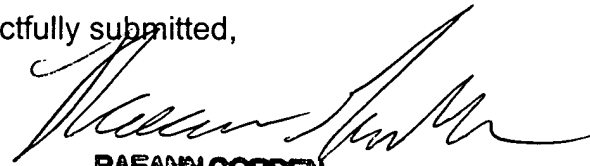
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satisfied. It is further submitted that appellant's claimed invention further comprising a polyurethane cover is disclosed by the combination of Nesbitt in view of Isaac. Nesbitt teaches the outer cover should be made from a soft material; polyurethane is known in the golfing art for providing soft cover layers. Moreover, the secondary reference, Isaac, teaches and provides reasoning for using a polyurethane cover as oppose to an ionomeric (surllyn) cover.

For the above reasons, it is believed that the rejections should be sustained.

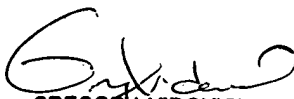
Respectfully submitted,

  
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March 5, 2005

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